

### **REMARKS**

By the foregoing amendments, claims 1, 16, and 21 have been amended and claims 2, 10 and 17 have been canceled, without prejudice. In view of these amendments and the following remarks, Applicant respectfully requests that the Examiner reconsider all the outstanding rejections and that they be withdrawn.

In paragraphs 3 and 4 of the office action, the Examiner continues to reject claims 1-24 under 35 U.S.C. 103(a) as being unpatentable over (1) Goyal et al. (U.S. Patent No. 5,873,108), (2) Koyabu et al. (U.S. Patent No. 6,026,333) (3) Conmy et al (6,101,480) in view of (4) Young et al. (2004/0008971).

In response to Applicant's last set of arguments presented, the Examiner indicates the following:

At pages 8-12 of the 8/8/06 response, Applicant argues that the newly added features in the 8/8/06 amendment are not taught or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 8/8/06 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Goyal, Koyabu, Conmy and Blasko, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action, and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Respectfully, Applicant contends that the Examiner combines not two, but four references to render the claimed inventions here as obvious. The number of references on its face suggests that it is not without hindsight that one skilled in the art would follow the logic detailed by the Examiner to combine the references as he suggests. Applicant submits that references cannot be combined based on hindsight provided by the present application. Absent a suggestion in the references that are combined that invites the combination, a combination of the references must take into consideration the other aspects emphasized by the courts, which are repeated below for the Examiner's convenience. The Examiner is respectfully requested to reconsider his rejections on the bases of the governing criteria as well the amendments to the independent claims. The claims recite that the systems and methods claimed here are specifically for a handheld device. Although the Examiner points to some sections in certain references to indicate that handheld device criteria are considered, each of the references applied do not demonstrate that. If indeed it were as obvious to one of ordinary skill in the art as the Examiner suggests, any one of these references would have described the claimed invention in its entirety.

Governing Criteria for U.S.C. Section 103

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

To resolve the issue of patentability based on obviousness, the examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)).

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to

this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

#### *Discussion of the 35 U.S.C. Section 103 Rejections*

##### Independent Claims 1 and 16

Regarding independent claims 1 and 16, embodiments of the presently claimed invention disclose a method of automating categorization of data in a handheld device (with computing capability), and instructions for implementing the method, as presently claimed. The claimed embodiments of independent claims 1 and 16 pertain to a method and instructions for implementing the method for automating the categorization of data on a handheld computer. Specifically, embodiments of the present invention recite that a default data category is set (which differentiates between business and personal hours) based upon a clock time of day (clock TOD), a day of the week, and a time of day profile (TOD profile) that is referenced. That is, the TOD profile correlates' clock time information and day of week information with a data category that is used as a default category. In particular, at least one data category in the handheld computer is associated with a block of time corresponding to two or more days of the

week. For example, a business data category may include a block of time from 9:00 a.m. to 5:00 p.m. on Monday through Friday of a week.

Applicant respectfully notes that the Goyal et al. reference in view of the Koyabu et al. and the Young et al. references do not suggest, teach, nor comprise the present invention as claimed in independent Claims 1 and 16 in which a default data category in a handheld computer is set based upon a clock TOD, day of week, and a TOD profile, wherein data categories can include a block of time corresponding specifically to two or more days. The Goyal et al. reference teaches a personal information manager with an information entry that allows for intermingling of items belonging to different categories within a single unified view. The Koyabu et al. reference teaches a data utilizing system that categorizes and tabulated existing records by a time period (e.g., a period of months) and a categorization rule in order to analyze trends in the market and in commercial goods based on the existing records.

Applicant agrees that the Goyal et al. and Koyabu et al. references do not explicitly disclose the present invention that is used for accessing stored data in a handheld computer and for storing entered data in the computer in a default data category determined by clock time of day, day of week, and a time of day profile. More particularly, Applicant respectfully asserts that the Goyal et al. reference and the Koyabu et al. references each fail to teach, suggest, or disclose setting a default data category in a handheld computer based upon a clock time of day, a day of the week, and a time of day profile, wherein at least one data category is associated with a block of time corresponding to two or more days.

Claims 1 and 16 are amended to incorporate the limitation of claims 2 and 17, respectively. With respect to these claims, the Examiner indicates the following:

As per claim 2, Goyal fails to expressly teach wherein the time of day profile correlates a clock time with at least one of a personal data category and a business category. However, this feature is old and well known in the art, as evidenced by Koyabu's teachings with regards to wherein the time of day profile correlates a time with at least one of a personal data category and a business category (Koyabu; col. 7, lines 35-53). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Goyal with Koyabu's teaching with regards to this limitation, with the motivation of associating a time of day with at least one of a

related personal data category and a business category (Koyabu; col. 1, lines 60-col. 2, line 5).

In Koyabu, the Examiner points to col. 7, lines 35-53, for teaching the recitation in the claims of “the time of day profile” correlating “to a time with a least one of a personal data category and a business category.” Applicant has studied that section and does not see how Koyabu teaches the claimed recitation.

Thus, the Goyal et al. reference taken alone or in combination with the Koyabu et al. and the other two references Conmy and Blasko, do not suggest or teach setting a default data category (which differentiates between business and personal hours) based upon a clock time of day, a day of the week, and a time of day profile, wherein at least one data category is associated with a block of time corresponding to two or more days, as is recited in independent Claims 1 and 16. The Examiner indicates that the motivation to combine these references need not be found in the references themselves, but in what they suggest to one versed in the art, rather than by their specific disclosures. To that end, as is well-established by the case law, such reasoning assumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. Applicant respectfully urges that given the disparate issue dates of the three references (February 16, 1999 (Goyal et al.), February 15, 2000 (Koyabu et al.), and August 8, 2000 (Conmy et al.)), the last barely one month before the filing date of the instant application, such knowledge can not be easily assumed.

Accordingly, Applicant respectfully submits that independent Claims 1 and 16, as amended, overcome the Examiner's basis for rejection. As such, Claims 3-8 which depend on independent Claim 1, and Claims 18-20 which depend on independent Claim 16, are also in a condition for allowance as being dependent on an allowable base claims.

#### Independent Claims 9 and 21

Independent Claims 9 and 21 recite similar limitations as the limitation discussed above in relation to the rejections of independent Claims 1 and 16. For similar reasons, it is respectfully submitted that independent Claims 9 and 21 are not rendered obvious over the Goyal et al. reference in view of the Koyabu et al. and the Conmy and Blasko. references. Specifically, the Goyal et al. reference taken alone or in combination with the Koyabu et al. and the Conmy and

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Blasko. references do not teach, suggest, or disclose setting a default data category (that establishes differences between business and personal hours) based upon a current time of day, day of week, and a time of day profile, wherein at least one data category is associated with a block of time corresponding to two or more days.

Claim 9 is amended to incorporate the limitations of claim 10. Allowance of independent Claims 9 and 21 is respectfully requested. Also, claims 11-15 which depend on independent Claim 9, and Claims 22-24, which depend on independent Claim 21 are also in a condition for allowance as being dependent on allowable base claims.

### CONCLUSION

In light of the facts and arguments presented herein, Applicant respectfully requests reconsideration of the rejected claims.

Based on the arguments presented above, Applicant respectfully asserts that Claims 1-24 overcome the rejections of record. Therefore, Applicant respectfully solicits allowance of these claims.

The Examiner is invited to contact Applicant's undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,  
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